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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,676	01/11/2002	Bernd Klinksiek	Mo6885/LeA 33,410	9095

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,676	KLINKSIEK ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2005 has been entered.

2. Claims 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been found for claim amendments specifying a solid ceramic sleeve and solid ceramic piston. The specification fails to recite that the components are solid ceramic, and despite applicants' arguments, it is by no means clear from the drawings that the components are solid ceramic or produced only from ceramic. Furthermore, in the absence of adequate definition, it is not clear exactly what construction is encompassed by the language, "solid ceramic sleeve" and "solid ceramic piston". The language can be fairly interpreted to simply mean that the components are not hollow or porous, and it is by no means clear that the language requires that the components be constructed of only a ceramic material.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahl et al. ('518) further in view of GB 997,974 in combination with Kasaya et al. ('178) and Kalsi ('320).

Kahl et al. disclose the production of an aqueous coating composition comprising a polyisocyanate and an isocyanate-reactive component, wherein the composition is produced by forcing the aqueous mixture through a jet disperser at a pressure of 1 to 30 Mpa. See abstract. Furthermore, Kahl et al. disclose that the jet disperser has features pertaining to the adjustability of the disperser, variable throughput, and the ability of the bores or slots to be opened electrically. See column 5, lines 12-30 and figure 6. Referring to figure 6, the manipulation of element 53 controls the opening and closing of the holes and, as a result, causes the jet disperser to be adjustable and to have variable throughput.

5. While Kahl et al. disclose jet dispersers having features corresponding to those of the claimed jet disperser, Kahl et al. fail to disclose jet dispersers that exactly correspond to those claimed; however, jet dispersers having the claimed pipe, sleeve, and piston arrangement were known at the time of invention and were further known to be useful for the production of dispersions and emulsions having finely dispersed components. This position is supported by the

teachings of GB 997,974 (see pages 2 and 3 and figure 2). Furthermore, though GB 997,974 is silent regarding such features as pneumatic control and the use of ceramic materials, these features were nonetheless known for use within valves at the time of invention. Kalsi disclose the use of pneumatic operators to control flow through valves and Kasaya et al. disclose at columns 3 and 4 the use of ceramic materials for the surfaces of valve components. Kasaya et al. further disclose that the use of ceramic materials is beneficial, because they provide abrasion resistance.

6. Therefore, since dispersers having the claimed pipe, sleeve, and piston arrangement were known at the time of invention to be useful for the production of fine dispersions, and since analogous dispersers were known to be useful for the production of aqueous polyurethane dispersions, the position is taken that it would have been obvious to produce the dispersions of Kahl et al. using the disperser of GB 997,974. The position is further taken in view of the teachings of Kahl et al. at column 5, lines 29 and 30, Kalsi, and Kasaya et al. that it would have been obvious to modify the disperser of GB 997,974 to be electrically or pneumatically controlled, so as to promote automation and precision of control, and to utilize ceramic materials, so as to extend service life and promote ease of cleaning.

7. Applicants' arguments have been considered; however, they are insufficient to overcome the prior art rejections. Applicants have argued that the instant ceramic sleeve and ceramic piston are solid parts, whereas the component parts of Kasaya et al. are ceramic coated steel parts. This argument is not found persuasive, because, as aforementioned within paragraph 2, it is by no means clear that the instant claim language excludes components that correspond to those of the prior art. The position is taken that the claim language merely requires the argued

parts to have a ceramic feature and be solid; therefore, the position is taken that the ceramic coated components of the prior art satisfy the claim requirements. Applicants argue that the instant invention seeks to avoid the use of steel components; therefore, applicants further argue that the steel components of the prior art teach away from the instant invention. This argument is not persuasive, because it fails to consider the prior art's modification of the steel parts by coating them with the ceramic material. Lastly, applicants refer to their findings that the use of ceramic components gound to fit very accurately avoid the leakage problem between piston and sleeve that is prevalent when the components are steel. This argument is deficient for the two following reasons. Firstly, the argument is not commensurate in scope with the claims, because there are no claim limitations governing the tolerances between the respective components. The requirement that ceramic is used in no way mandates that tight tolerances are required. Secondly, applicants have not established that the ceramic coated components of the prior art are subject to the aforementioned leakage problem. Applicants' arguments concerning the likelihood of the components of Kasaya et al. demonstrating increased leakage amount to unsubstantiated opinion. In summation, applicants' response is primarily concerned with arguing that the components of the prior art are steel and fails to appreciate or address the advantages resulting from the use of the ceramic coating of the steel components.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 6-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 24, and 25 of copending Application No. 10/789,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a process for producing an aqueous two-component isocyanate-based coating composition, wherein the aqueous composition is passed through a jet disperser under equivalent pressures. The position is taken that the jet disperser of 10/789,026 is not patentably distinct from the instantly claimed jet disperser.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
March 10, 2005

RABON SERGENT
PRIMARY EXAMINER